



### REMARKS

After several years of expensive prosecution and interviews, the Examiner went back to ground zero and imposed a restriction requirement. Now, in the Office Action of February 24, 2005, the Examiner rejects the elected Claims 1-6 and 13-17. In view of the following comments, reconsideration and withdrawal of the rejections are respectfully requested, and allowance of those claims and new claims focusing on the packing configuration, are also respectfully requested.

#### **°Rejection of Claims 1-6, 13 and 16-17 For Anticipation**

Claims 1-6, 13 and 16-17 were rejected as anticipated by Hauser. Claims 2-6, 13 and 16-17 depend from Claim 1.

**Claim 1** defines a package for mailing items from a merchant to a customer. The package has a surface with a bar code on the surface, "wherein the bar code identifies the customer." Those claim requirements are not met by Hauser, which provides a non-affixed label with a barcode on the label, and the customer at some later date puts the label on a newly selected package to ship returned items to a clearing house. This is discussed below. But Claim 1 is also amended to define a barcode with a return history of prior purchases other than the item currently mailed. That further distinguishes Hauser.

Claim 1 defines a package having a barcode on that package surface for mailing to a customer. The portions of Hauser cited by the Examiner show that the barcode is on an unattached label, not on any package for mailing by the merchant to the customer. As such, Hauser does not meet the claim requirements.

The assertion that "Hauser teaches a package (e.g., goods, merchandise, etc) for mailing items from a merchant to a customer" is NOT correct. *See* Office Action at ¶3, pg. 2. The cited text actually says that an unaffixed label with a barcode can be given to the customer when the merchandise is purchased. Col. 2, lines 19-20 ("the return label can be provided with the merchandise when purchased by the customer . . ."). The text does not say the merchandise is in a package, it does not say the merchandise is in a mailing package and it does not say the label is affixed to a mailing package.

The text certainly does not put the label on the surface of the package which the merchant mails to a customer. The cited text implies the customer picks up and carries the package out. Indeed, the customer selects “an appropriate package” in which to return selected items. Col. 4, lines 37-38 (the customer will pack the merchandise to be returned in an appropriate container”). Thus, Hauser’s label is not applied to the package defined in the claim.

Only when a customer is dissatisfied with the purchase is Hauser’s label put on a package, with the package being selected by the customer for repacking and shipping. Col. 8, lines 3-9. Thus, Hauser’s label is not placed on a surface of a package for mailing items from a merchant to a customer. The label is applied only to a package selected by the customer as appropriate to return one or more items:

Upon receiving the return authorization label, as indicated in block 20, **the customer will pack the merchandise to be returned in an appropriate container, apply the label to the container**, and will then arrange for shipment of the merchandise to the central return facility of Returns Online, Inc.” [Col. 4, lines 35-40 (emphasis added)].

The customer picks the package and applies the label to the customer-selected package. The customer sends the label to a third party return facility.

For anticipation under §102, all claim requirements must be found in the Hauser patent. The claim requires a package from a merchant to a customer having a surface on the package bearing a bar code. The requirement is not met, so there can be no anticipation.

As this requirement of Claim 1 is not met, there can be no anticipation of Claim 1. Reconsideration and withdrawal of the anticipation rejection of Claim 1 is requested.

Further, Claim 1 defines a package for mailing items from a merchant to a customer. Nothing in Hauser specifies that the merchant give the customer merchandise in a package for mailing. Such packaging is typically not suitable for mailing as customers carry the merchandise out of the store in Hauser’s scenario. That is also why the customer packs the merchandise “in an appropriate container.” Col. 4, lines 36-40.

As this additional requirement is not met, there is also no anticipation of Claim 1.

Claims 2-4, 13 and 16 depend on Claim 1 and were also rejected as anticipated. Reconsideration and withdrawal of the anticipation rejection of those claims is also requested.

**Claim 2** defined a bar code including “a complete order and return history for the customer.” A portion of this history requirement is added to Claim 1 so the history requirement is also discussed here. The text cited by the Examiner refers only to the item purchased and returned by the customer. Abstract, Col. 2, lines 13-15, lines 19-20, lines 53-55. That does not give any customer history as it is limited to only the current item. Hauser thus provides only limited information and on only the current transaction. There is no indication of prior purchases or returns on other items, or lack of prior purchases or returns on other items. Hauser does not disclose these return history as now defined in Claim 1.

**Claim 3** specifies a package marked by the merchant with the return address of the merchant. Hauser’s label has the return address of the National Return Center, not the address of the merchant. Col. 4. lines 39-40. The requirements of Claim 3 are not met.

**Amended Independent Claim 5** defines a method for tracking a return history of a customer, which includes the step of having a merchant provide a package suitable for mailing a product to the customer. Hauser does not disclose this mailing package.

Claim 5 also defines the merchant providing a package with a barcode on an exterior of the package, with the barcode identifying the customer. Hauser does not have this.

Claim 5 also defines the step of updating the customer’s order and return history. This updating is said to be identically disclosed at Col. 2, lines 49-67 and Col. 5, lines 21-44 of Hauser. Those portions do not disclose any updating of customer return history.

The cited proportion of Column 2 cited by the Examiner, describe a report on the condition and disposition of the returned merchandise so the “merchant can track the handling of the returned merchandise through its final destination.” The cited portion of Column 5 discusses refunding the customers purchase price. Neither cited portion refers to an order history or updating that history. The information focuses on an isolated portion of a current transaction involving the return of a product. Further, if the history is updated it is clear that “updating the history” requires more than one event purchase or return event.

Tracking a single return and crediting the money of the returned item does not comprise “updating” a “history.”

Claim 6 depends from Claim 5, and is allowable for the same reasons as Claim 5.

**Obviousness Rejection of Claims 14-15**

Claims 14-15 were rejected as obvious over Hauser in view of Savino (6,015,167).

Claims 14-15 depend from Claim 1 and are allowable for the same reasons as Claim 1.

Claims 14-15 further define a barcode that includes the customer’s name (Claim 14) and address (Claim 15). As discussed above, Hauser does not disclose the defined package for mailing, or the label a surface of that package. Savino is cited for only the name and address of the customer, specifically Fig. 3 and Col. 3, line 62 to Col. 4, line 35 of Savino. Savino is not said to cure the other deficiencies of Hauser discussed above.

There is no proper suggestion to combine Hauser and Savino. Hauser involves a return center that never refunds money to the customer, and that tracks merchandise by the merchant authorizing the return. The merchant authorizes the return, and sends information to the return center. Col. 4, lines 9-14. But processing of the returned merchandise is “based on the merchant identified by the bar code on the shipping label.” Col. 6, lines 36-41 (“once the receiving station scans a return authorization label to identify the merchant who authorized the return . . .”). Some merchants resell merchandise, discard damaged merchandise, or give it to charity, etc. See end of Col. 4 to Col. 6, line 17. In those instances there is no need to identify the customer to the processing center and no disclosure in Hauser states that the customer’s name and address is provided to the processing center.

Hauser gives a customer a label so the customer can send merchandise to the third party return center. The third party center verifies the receipt and condition of the expected merchandise. The merchant then issues a refund. Col. 5, lines 6-19. All the return center needs is limited information on the expected merchandise, which the merchant provides. The receiving center does not need to know the customer’s name or address. Indeed, upon authorization of the return, the only information needed and provided on the label is the address of the return center (not the customer’s name and address). Col. 6, lines 20-49.

In contrast to Hauser, Savino involves internet purchases where the customer never physically enters the store and instead receives the merchandise through the mail. Thus, in

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Savino the customer's name and address are critical to getting the merchandise to the customer. But there is no proper suggestion to combine these two different business methods which focus on two different situations, and which require two different sets of information.

The Examiner says it is obvious to add Savino's name and address information to the label of Hauser in order to positively identify the customer's name and residence. But the label in Hauser is used to allow the customer to return merchandise to a third party return center. There is no need for the label to include the customer's name and address. There is thus no suggestion to combine the references and provide information that is not essential to Hauser. The Examiner is urged to avoid the temptation of using hindsight to pick and choose isolated features from the prior art.

Reconsideration and withdrawal of the rejection of Claims 14-15 is requested.

**Claims 20-48 (New)**

New claims are added primarily focusing on the construction of the packaging as shown in Figures 1-4 and described in the application. No new matter is added.

**Conclusion**

In view of the above comments, reconsideration and withdrawal of the rejection of the claims is requested.

If any additional fee is required, please charge Deposit Account Number 19-4330.

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